

Remarks

Applicant has amended Claim 4. No new matter is added by this Amendment. Entry of this Amendment, and favorable consideration thereof, is earnestly requested.

The Examiner has rejected Claims 4 under 35 U.S.C. 112 as being indefinite. The Examiner has further rejected Claims 1 – 2, 7, 10 – 11 and 20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 3,351,073 to Gregg (hereinafter "Gregg"). The Examiner has further rejected Claims 3 – 6, 8 – 9, and 12 – 19 under 35 U.S.C. 103(a) as being unpatentable over Gregg in view of U.S. Patent 3,197,787 to Tognan (hereinafter "Tognan"). These rejections are respectfully traversed.

Rejections under 35 U.S.C. §112

The Examiner has rejected Claims 4 under 35 U.S.C. 112 as being indefinite with respect to the limitation "said fabric." Claim 4 has been amended to depend from Claim 3 which includes antecedent basis for this limitation.

Rejection under 35 U.S.C. §103(a)

The Examiner has rejected Claims 1 – 2, 7, 10 – 11 and 20 under 35 U.S.C. 103(a) as being unpatentable over Gregg. As indicated by the Examiner, however, Gregg fails to disclose a hair retainer with a "lip having a diameter and said upper edge having a diameter smaller than the said lip diameter to form a frustoconical collar for retaining hair." The Applicant respectfully disagrees that such limitations involve only a mere change in shape. While in some cases the particular shape of a product is of no patentable significance, the shape is important when it results in a product which is distinct from the reference product. *Ex parte Hilton*, 148 USPQ 356 (Bd. App. 1965).

The Applicant respectfully submits that the frustoconical shape of the present invention is distinct and provides significant advantages over the prior art. As illustrated in the Applicant's Specification, "Hair retainer 40, when placed on the head 12 of the wearer, is frustoconical in shape and sufficiently stiff to retain that shape and prevent it from resting upon the hair 14 on the wearer's head 12. This prevents the disturbance of any hairstyle while keeping hair 12 from falling forward onto the face 16." Specification, Para. 0012 (emphasis added).

To the complete contrary, Gregg teaches a coiffure including an upper support "adapted to support the more delicately upper hair designs." Col. 4, lines 28 – 32. In Gregg, "the net band 22 thus readily conforms to the more delicately hair styles... yet is sufficiently substantial to effectively hold the pair." Col. 3, lines 39 – 41. In fact, by teaching such a device which conforms to and supports the hair, Gregg specifically teaches away from the claimed invention. It is well settled that a prima facie case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). Gregg recognizes that it is desired that some areas, such as the forehead, be free from the "disturbing contact" of the coiffure. Col. 4, 30 – 35. However, rather than employing a "frustoconical collar" or "frustoconically shaped hair retainer" as required by all pending claims, Gregg teaches a far less advantageous solution of "cutting out a top portion" and "leaving a free area above the forehead 16 to leave untouched a lady's bangs" and "to prevent any disturbing contact on the front hair or bangs." Col. 2, lines 8 – 13, 50 – 53; Col. 4, 30-35; FIG. 4.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Gregg specifically teaches away from a "frustoconical collar" and "frusto-

conically shaped hair retainer" as required by all pending claims and therefore can not render Claims 1 – 2, 7, 10 – 11 and 20, or any one of the Claims 1 – 20, obvious.

Furthermore, while Applicant insists that Gregg teach away from each of the Claims 1 – 20 which require a "frustoconical collar" or "frustoconically shaped hair retainer", the Applicant draws further attention to Claims 2 and 11 which require that said hair retainer "comprises a stiff material and is at least partially rigid so as to maintain a frustoconical shape and not rest upon said hair when placed on said wearer's head" and "is at least partially stiff to maintain said hair retainer as frustoconical in shape and prevent said hair retainer from resting upon said hair", respectively. The limitations of Claims 2 and 11 are directly contradictory to the teachings of Gregg and therefore cannot be rendered obvious.

The Examiner further rejected Claims 3-6, 8 – 9, and 12 – 19 under 35 U.S.C. 103(a) as being unpatentable over Gregg in view of Tognan. The Applicant respectfully submits that neither Gregg nor Tognan teach a "'frustoconical collar" or "frustoconically shaped hair retainer" as required by the pending claims. As Tognan fails to provide the missing teachings of Gregg, no combination thereof can render any one of the Claims 1 – 20 obvious.

Tognan teaches "a head covering to be worn over hair curlers, rollers, or other hair settling devices" "to cushion the head of the wearer when reclining." Col. 1, lines 8 – 11. Unlike the claimed invention, Tognan further teaches a device which "conforms substantially to the contour of the hairdo set" and "conform to the contour of the coiffure as set with curlers." Col. 1, lines 45 – 47, 65 – 67. As such, Tognan also specifically teaches away from a "frustoconical collar" or "frustoconically shaped hair retainer" required by all pending claims. In fact, not only does Tognan teach a device which conforms to the contour of the hair, the device "will maintain said curlers in a proper posi-

tion." Col. 3, lines 21 – 26. Therefore, no combination of Gregg and Tognan can render Claims 3 – 6, 8 – 9, and 12 – 19, or any of the Claims 1 – 20, obvious.

Finally, neither Greg nor Tognan disclose or suggest a hair band that is continuous as required by Claims 5, 6, 8, and 14 – 19. Claims 5 and 6 require a "continuous elastic disposed within a fabric covering", Claim 8 requires "a continuous elastic band disposed in a fabric covering", and Claims 14 – 19 require a hair band comprising a "continuous twofold fabric." To the contrary, both Gregg and Tognan teach protectors that are discontinuous and require various fastening means. Gregg teaches a protector 11 that is held on the head by means of narrow extending end regions and mating faces equipped with Velcro tabs. Col. 3, lines 61-68; FIG. 1 & 2. Tognan teaches "draw tapes 22 and 23... employed to secure the head covering band 10 in place on the head." Col. 2, lines 31-32; FIG. 2. Tognan even suggests that the discontinuous design is advantageous because it allows the device to "accommodate different arrangements or styles of coiffures and different head sizes." Col. 2, lines 34-35.

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Applicant respectfully submits that neither Gregg nor Tognan suggest a continuous hair band and that the Examiner has failed to provide any reasoning as to why the corresponding limitations of Claims 5, 6, 8, and 14-19 would have been obvious in light of their teachings.

For the foregoing reasons, it is respectfully submitted that Claims 1 – 20, all of the pending claims, are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,



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EXAMINER

DOAN, ROBYN KIEU

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 05/03/2006



Please find below and/or attached an Office communication concerning this application or proceeding.

**Application No.**

10/706,556

Applicant(s)

BALDWIN, J. HANNAH

Examiner

Robyn Doan

Art Unit

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's Amendment filed 2/02/06 has been entered and carefully considered.

Claims 1, 7, 14 and 20 have been amended. Limitations of amended claims have not been found to be patentable over newly discovered prior art, therefore, claims 1-20 are rejected under the new ground rejections as set forth below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "said fabric" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 7, 10-11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregg (U.S. Pat. # 3,351,073).

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With regard to claims 1, 7, 10, and 20, Gregg discloses a hair retaining device (figs. 1 and 4) comprising an annular, elasticized band (10, col. 2, lines 1-4; Applicant is noted that Gregg shows a rectangular band 10, however when closed by fastener 32, 30, it becomes an annular elasticized band) for adjusting (using fasteners, 30, 32) to heads of varying sizes and for encircling a wearer's head, the band contracting about the wearer's head and having an upper edge (at 12, 14) with a diameter, a hair retainer (22) gathered at and extending from the upper edge of the elasticized band (10) and terminating at a generally circular retaining lip circumscribing an opening (figs. 1 and 4); the lip also having a diameter. Gregg does not disclose the hair retainer having a frustoconical shape and the diameter of the upper edge being smaller than the lip's diameter. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the hair retainer having a frustoconical shape and the diameter of the upper edge being smaller than the lip's diameter, since such modifications would have involved a mere change in the shape and size of the known component. A change in shape and size is generally recognized as being within the level or ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). In regard to claims 2 and 11, Gregg also shows the hair retainer having a stiff material and being at least partially rigid (col. 3, lines 34-39).

Claims 3-6, 8-9 and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregg in view of Tognan et al (U.S. Pat. # 3,197,787).

With regard to claims 3-6, 8-9 and 12-19, Gregg discloses a hair retaining device comprising all the claimed limitations in claims 1, 7 as discussed above except for a continuous twofold fabric having an interior and an exterior surfaces forming an annular inner edge and an annular outer edge, the elastic portion being disposed within a first portion of the interior surface and the stiffening material being disposed with a second portion of the interior surface of the twofold fabric, the material of the fabric being terry cloth and the material of the stiffening material being mesh. Gregg also does not disclose the elastic and the fabric covering being puckered to allow the elastic to expand. Tognan et al discloses a hair retainer (figs. 1 and 3) comprising a twofold fabric material (at 20, 21, fig. 3, col. 2, line 16) having an interior and an exterior surfaces forming an annular inner edge and an annular outer edge, a drawing tape (22) being disposed within the interior surface of the twofold fabric for protecting the drawing tape. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the technique of using the twofold fabric material as taught by Tognan et al to cover the elastic portion and the stiffening material of Gregg in order to provide a covering to protect the elastic and the stiffening materials. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the material of the fabric being terry cloth and the material of the stiffening material being mesh, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. and it would also have been an obvious matter of design choice to construct the elastic portion and

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the fabric covering being puckered, since such a modification would involved a routine skill in the art.

Conclusion

Applicant's arguments with respect to claims 1, 7, 14 and 20 have been considered but are moot in view of the new ground(s) of rejection.

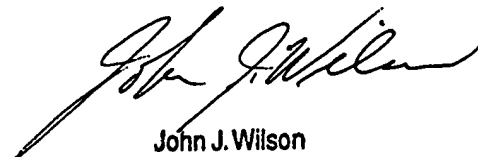
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robyn Doan
Examiner
Art Unit 3732



John J. Wilson
Primary Examiner